

RESPONSE TO REQUIREMENT FOR RESTRICTION

Applicants respectfully submit that New Claims 11-13 fall within Group I, as defined by the Examiner, and new Claims 14-27 fall within Group II, as defined by the Examiner. Applicants therefore elect, with traverse, Group I, Claims 1-7 and 11-13, drawn to a polishing composition.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-7, drawn to polishing liquid compositions; and

Group II: Claims 9-10, drawn to a polishing method.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of Groups I and II as related as product and process of use. Citing M.P.E.P. §806.05(h), the Office suggests that the claimed process can be practiced with “another materially different product such as one that does not require polishing with a polishing liquid composition.” However, the Office has merely concluded that the claimed process can be practiced with “another materially different product” but has provided no evident or examples of what such “another materially different product” might be, nor has the Office shown how this other product is “materially different” from the claimed product.

Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

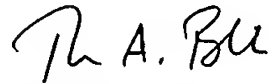
Applicants note that M.P.E.P. §821.04 states, “If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.” Applicants respectfully submit that should the elected group be found allowable, the nonelected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore respectfully request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Thomas A. Blinka
Registration No. 44,541



22850

703-413-3000
Fax #: 703-413-2220
TAB/rac